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10/072,823	02/08/2002	Sophie Chen	NOV-0001	1435
23413	7590	03/02/2005	EXAMINER	
CANTOR COLBURN, LLP			MELLER, MICHAEL V	
55 GRIFFIN ROAD SOUTH				
BLOOMFIELD, CT 06002			ART UNIT	PAPER NUMBER
			1654	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/072,823
Filing Date: February 08, 2002
Appellant(s): CHEN, SOPHIE

Karen LeCuyer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/1/2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because there is no reasons why the claims stand or fall together only a statement that they stand together which is agreed upon. They stand or fall together since one 35 USC 103 rejection was made over all the claims on the same pieces of prior art.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

JP 11236334	Nissin Shokuhin Kaisha	8-1999
JP 52145509	Matsui T.	12-1977
JP 352102434	Fujita et al.	8-1977
JP 57167938	Taiho Pharm. Co. Ltd.	10-1982
UK 1476016	Fujita et al.	6-1977

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9, 11-16, 18-23, 26-29, 32-35 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over JP 57167938 (JP '938), GB 1476016 (GB) or JP 352102434 (JP '434) taken with JP 11236334 (JP '334) or JP 52145509 (JP '509).

JP '938, JP '434 and GB teach oridonin used to treat cancer.

JP '334 or 509 teach extracts from *Humulus lupulus* which are used for treating cancer. Lupulone is very well known in the art to be in extracts of *Humulus lupulus* (hops) as readily admitted by appellant at bottom of page 2 of their own specification and they even supplied a well known reference to show this. Accordingly, lupulone would inherently be contained within such extracts.

It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re Sussman*, 1943 C.D. 518; *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

Thus, since each component is known individually in the prior art for the same purpose, i.e. to treat cancer, then it would have been obvious to combine the two components into one formulation.

(11) Response to Argument

Appellants first argue that JP '334 does not teach the type of cancers that it treats. Fact is, JP'334 treats cancer as do all the other references, thus it would have been obvious to put the two components together. Appellant is trying to change the topic at hand which is the motivation to combine oridonin and lupulone into one composition. Since the clearly show that individually in the prior art of record lupulone and oridonin are used to treat cancer then it would have been obvious to one of ordinary skill in the art to combine lupulone and oridonin together to make a third composition to treat cancer. All that is required is that the components individually in the art are known to be used for the same purpose, which they are.

Appellants next argue that the references teach different types of cancer treated in each reference and therefore they are not properly combinable. Fact is, the references each teach anti-cancer treatment and never specify what type of cancer that they are treating. The claims are to a composition not to a method of treating a specific type of cancer. All that is required is that there is a clear motivation to combine the two

ingredients together (lupulone and oridonin) to create a third composition which has the same purpose as the two ingredients, which is true.

Appellants next argue that JP '509 cannot contain the claimed lupulone since appellants argue that lupulone allegedly cannot be extracted with water. There were no arguments on the record to ever reflect this fact and no such evidence has been offered by appellant. Appellant had the burden of supplying this alleged evidence which was never presented by them, thus the statements are without merit.

Appellants provided a reference by Todd Golub saying that new drug combinations for cancer treatments are very successful and that the older ones have been unsuccessful in the past. While this is what the reference might be saying, the author was not referring to appellant's invention. Mr. Golub was referring to some other combination and not appellant's claimed combination. Thus, the article really does not add anything at all.

Appellants next argue that the extracts from the plants in the references are not plant extracts and this is simply not agreed with. Anytime a plant is squeezed, ground, etc. a plant extract results by definition. Thus, the references do in fact, teach plants extracts.

Appellant next continues to argue case law. The case law is simple. If you have two components individually used in the art for the same purpose and a composition of the two is being claimed then it would have been *prima facie* obvious to combine them into one composition. The motivation being that two or more components are already

known in the art individually for the same purpose (as an anti-cancer agent) and it would then follow that combining the two components can only enhance their desired effect.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Michael V. Meller
Primary Examiner
Art Unit 1654

MVM
February 15, 2005

Conferees:

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